

REMARKS

Claims 13-23 were pending in the case. Upon entry of this Amendment, Claims 13-23 will be canceled and Claims 24-31 will be newly added.

With regard to the election requirement, Applicants hereby elect Group I where Q is the moiety Q-1 and Claims 24-31 have been so limited. Thus the present claims are directed to the compounds and compositions where Q is Q-1, a process of preparation of said compound and composition, and a method of using said compound for controlling unwanted microorganisms. It is believed the restriction requirement has been fully met.

Applicants acknowledge with appreciation the Examiner noting receipt of the Information Disclosure Statement and for returning the PTO Form 1449.

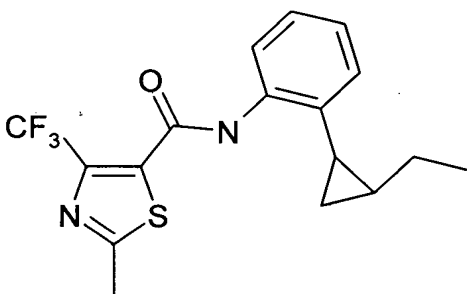
With regard to the claim for priority, Applicants are in the process of preparing the certified English language translation of the priority document, and will furnish it as soon as it is available.

With regard to the double patenting rejection over co pending U.S. Patent Application Serial Nos. 10/530513 and 10/502994, Applicants point out the following. The present claims are directed to thiazolylcarboxanilides wherein the aniline moiety is substituted by non-aromatic substituents, such as cycloalkyl, cycloalkenyl or bicycloalkyl, whereas the thiazolylcarboxanilides disclosed in both copending applications are biphenylcarboxanilides where the aniline moiety is substituted by aromatic systems.. Thus the present application is clearly distinguished over the two copending patent applications. Applicants respectfully request withdrawal of the double patenting rejection in this case.

With regard to the rejection under 35 U.S.C. Section 102(b) over Schelberger et al and Eicken et al, here again, those references are directed to compounds where the aniline moiety is substituted by aromatic systems in contrast to the present invention's non-aromatic substitution. Neither reference anticipates the present invention, and withdrawal of the 35 U.S.C. Section 102(b) rejections are respectfully requested.

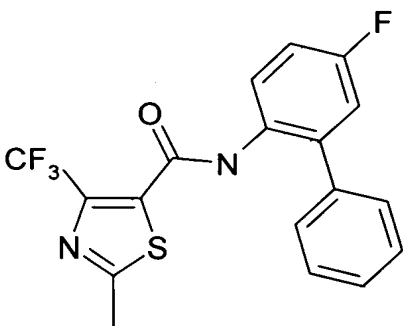
With regard to the rejections under 35 U.S.C. Section 103 over the references listed on Page 17, first paragraph of the Office Action, Applicants point out the following.

Ehrenfreund (WO 2003/074491) teaches compounds according formula 4.1:



The feature distinguishing the present invention is the CHF₂-group in 4-position of the thiazol moiety, rather than the CF₃-group as taught by Ehrenfreund.

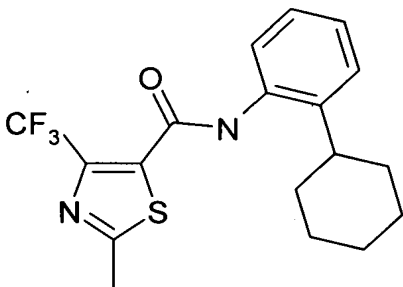
Eicken (US 5,998,450) teaches compounds according to formula A2:



However, the features distinguishing the present invention are:

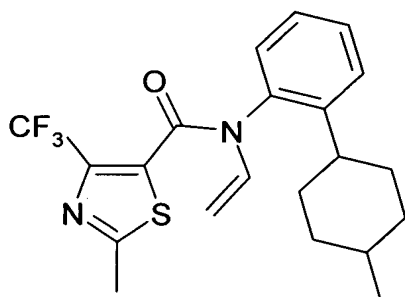
1. non-aromatic substituents attached to the aniline moiety
2. the CHF₂-group in 4-position of the thiazol moiety, rather than the CF₃-group.

Eicken (US 5,480,897) teaches compounds according to formula 9.53:



The feature distinguishing the present invention is the CHF₂-group in 4-position of the thiazol moiety, rather than the CF₃-group as taught by Eicken '897.

Walter (WO 2002/059086) teaches compounds according to formula 4.03:



However, the features distinguishing the present invention are:

1. the chemical nature of the substituent attached to the amide-nitrogen.
2. the CHF₂-group in 4-position of the thiazol moiety, rather than the CF₃-group.

The examiner is of the opinion that it is rendered obvious by Patani to al. to exchange a fluorine atom of the CF₃-group by hydrogen. But, from the analysis above it becomes evident that the closest prior art, i.e. the most promising starting point for the skilled person would have been either Ehrenfreund or Eicken 897, but where is the teaching to modify them to arrive at the present invention?

Applicants respectfully assert that nothing in the references motivates or suggests the presently claim compounds, and that is it only armed with impermissible hindsight, using the present invention as a guide, that one would be motivated to modify the compounds of the prior art to arrive at the present invention. This is clearly not permitted.

(MPEP Section 2142 states that "the tendency to resort to "hindsight" based upon applicant's disclosures is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.")

As noted in MPEP Section 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed Cir. 1992).
CS8484

Clearly, there is no such teaching, suggestion or motivation shown in either reference in this case. If the Examiner is relying on knowledge generally available to one of ordinary skill in the art, MPEP Section 2144.03 states that if Applicant traverses such an assertion, and Applicants do in this case, the Examiner should cite a reference in support of his or her position. Applicants hereby request such a reference. If the Examiner is relying on facts within his personal knowledge, Applicants respectfully request and are calling for, pursuant to MPEP Section 2144.03 and 37 C.F.R. Section 104, that the Examiner support such facts by an Affidavit.

Applicants' respectfully caution the Examiner about making conclusory statements not supported by objective evidence. As set forth in the very recent case of *In re Lee*, 61 USPQ2d 1430 (CAFC January 18, 2002):

As applied to the determination of patentability *vel non* when the issue is obviousness, "it is fundamental that rejections under 35 U.S.C. §103 **must be based on evidence** comprehended by the language of that section." *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775(Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008(Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the *Graham* factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record.

This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting

C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617(Fed. Cir. 1999) (**“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.”**); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637(Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600(Fed. Cir. 1988) (“teachings of references can be combined *only* if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933(Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317(Fed. Cir. 2000) (**“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”**); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459(Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.

In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”; *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783(Fed. Cir. 1992) (**the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”**).

[2] With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. **The examiner's conclusory statements** that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” **do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.”** *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's

conclusion.

....

Conclusory statements such as those here provided do not fulfill the agency's obligation. This court explained in *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697, that **"deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'"** The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

....

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of "the person having ordinary skill in the art to which said subject matter pertains," the words of section 103. In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. **Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record.** The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

Emphasis Added.

Thus, Applicants respectfully request a reference that motivates teaches or suggests selecting the radicals that have been selected in this case to form the definition for Q and the remaining radicals, and to place those radicals at the specific positions in a compound defined as the compound of the formula (I).

Moreover, the claimed compounds of the present invention have demonstrated unexpectedly superior results over "similar" compounds. Applicants have tested and found that there is an unexpectedly superior result for the CF₂ versus CF₃ moieties as shown in example attached hereto as **ATTACHMENT A**.

If the Examiner requires or desires, the results shown in Attachment A can be provided in the form of a Declaration, and the undersigned asks the Examiner to telephone the undersigned to provide such a declaration before issuing another

Office Action if that is what the Examiner requires/desires.

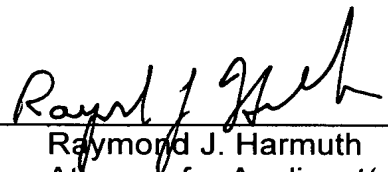
With regard to the Claim Objections stated on Page 24 of the Office Action, it is believed that the presently amended claims overcome that objection, and withdrawal of the objection is respectfully requested.

With regard to the specification misspellings, Applicants have amended the specification to correct those misspellings, and it is believed the objection is overcome. Withdrawal of the objection to the specification is respectfully requested.

In view of the preceding amendments and remarks, allowance of the claims is respectfully requested.

The Director is hereby authorized to charge any fee(s) associated with this filing to Deposit account no. 50-2510.

Respectfully submitted,

By 
Raymond J. Harmuth
Attorney for Applicant(s)
Reg. No. 33, 896

Bayer CropScience LP
2 T.W. Alexander Drive
Research Triangle Park, NC 27709
Ph: 919-549-2102
Fax: 919-549-3994
q/patents/strickland/cs8484/amendment 6-18-07

ATTACHMENT A



Example

Sphaerotheca test (cucumbers) / protective

Solvent: 24,5 parts by weight of acetone
24,5 parts by weight of dimethylacetamide
Emulsifier: 1 part by weight of alkylaryl polyglycol ether

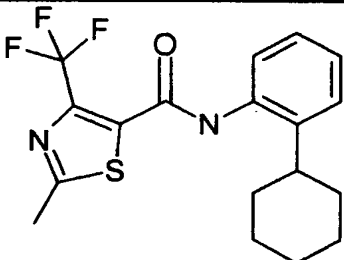
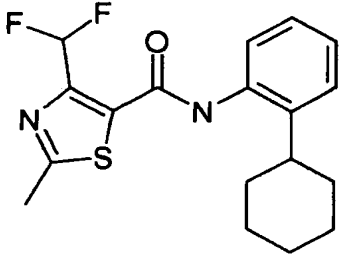
To produce a suitable preparation of active compound, 1 part by weight of active compound is mixed with the stated amounts of solvent and emulsifier, and the concentrate is diluted with water to the desired concentration.

To test for protect activity, young plants are sprayed with the preparation of active compound at the stated rate of application. After the spray coating has dried on, the plants are inoculated with an aqueous spore suspension of **Sphaerotheca fuliginea**. The plants are then placed in a greenhouse at approximately 23°C and a relative atmospheric humidity of approximately 70 %.

The test is evaluated 7 days after the inoculation. 0% means an efficacy which corresponds to that of the control, while an efficacy of 100% means that no disease is observed.

ATTACHMENT A

Table**Sphaerotheca test (cucumbers) / protective**

Active compound	Rate of application of active compound in ppm	Efficacy in %
<u>Known from 9.53 Eicken 897:</u>		
	100	67
<u>According to the invention</u>		
	100	89